

REMARKS

The Office Action dated March 21, 2003 has been carefully reviewed and the following response has been made in consequence thereof.

Claims 1-20 are now pending in this application. Claims 1-20 stand rejected.

In accordance with 37 C.F.R. 1.136(a), a three month extension of time is submitted herewith to extend the due date of the response to the Office Action dated March 21, 2003, for the above-identified patent application from June 21, 2003, through and including September 21, 2003. In accordance with 37 C.F.R. 1.17(a)(3), authorization to charge a deposit account in the amount of \$930.00 to cover this extension of time request also is submitted herewith.

The objection to the Claim 4 is respectfully traversed. Claim 4 has been amended to address the informalities noted within the Office Action. For the reasons set forth above, Applicants respectfully request that the objection to Claim 4 be withdrawn.

The rejection of Claims 1-4 and 14-20 under 35 U.S.C. § 103(a) as being unpatentable over Fisher et al. (U.S. Patent No. 6,005,314) ("Fisher") in view of Admitted Prior Art ("APA") of Figure 1 in view of Story et al. (U.S. Patent No. 3,787,014) ("Story") and in further view of Boede et al. (U.S. Patent No. 4,933,809) ("Boede") is respectfully traversed.

Fisher describes a motor (50) that includes a housing (54) formed by a motor shell (56) and a pair of endshields (58 and 60). A stator (72) is mounted within the motor shell. The motor also includes a base (92) for support and mounting. Notably, Fisher does not describe nor suggest a method for mounting a motor to a support that includes attaching fasteners to an inner surface of a housing using a plurality of attachment points within the housing such that the fasteners extend radially outwardly from the housing, and attaching the motor to a support using the plurality of fasteners. Additionally, Fisher does not describe nor suggest a housing that includes at least one raised projection extending outwardly from the housing wherein the projection includes an inner surface, at least one opening extending therethrough, and at least one fastener configured to attach to the inner surface and extend outwardly through the housing.

APA describes a motor housing (10) that includes a shell (12) having an inner surface (14) and an outer surface (16). A plurality of mounting hardware or fasteners (20) are attached to the shell outer surface and extend radially outwardly from the shell outer surface. Fasteners (20) are spaced circumferentially around the housing and may be welded to shell outer surface (16).

Story describes a replacement motor mounting (50) that includes an adapter bracket (58) that includes a circular central portion and four arms. A set of fastener receiving holes (62, 64) is formed in the arms and is configured to receive a plurality of fasteners (66) extending axially from an endshield. Notably, Story does not describe nor suggest at least one fastener configured to attach to an inner surface of a motor housing and extend outwardly through the motor housing.

Boede describes a modular assembly of diverse electrical components housed in a box (10). The box is closed with a cover (47) that includes a plurality of recessed mounting holes (56) configured to receive a plurality of mounting screws (52). Notably, Boede does not describe nor suggest at least one fastener configured to attach to an inner surface of a motor housing and extend outwardly through the motor housing. Rather, Boede describes fasteners that are configured to attach to an outer surface of an electrical component box and extend inwardly through the box.

Claim 1 recites “a method for mounting a motor to a support using a mounting system, the mounting system including a plurality of fasteners, the motor including a pair of endshields and a housing extending therebetween, the housing including a plurality of recessed openings and an inner surface, said method comprising: attaching the fasteners through the openings in the recesses formed in the housing such that the fasteners extend radially outwardly through the housing and a head of the fasteners is substantially co-planar with an un-recessed inner surface of the housing; and attaching the motor to the support using the plurality of fasteners.”

None of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a method for mounting a motor to a support using a mounting system, the mounting system including a plurality of fasteners, the motor including a pair of endshields and a housing extending therebetween, the housing including a plurality of recessed openings

and an inner surface, the method including attaching the fasteners through the openings in the recesses formed in the housing such that the fasteners extend radially outwardly through the housing and a head of the fasteners is substantially co-planar with an un-recessed inner surface of the housing, and attaching the motor to the support using the plurality of fasteners.

More specifically, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a method for mounting a motor to a support that includes attaching the fasteners through openings in the recesses formed in the housing, such that the fasteners extend radially outwardly through the housing and a head of the fasteners is substantially co-planar with an un-recessed inner surface of the housing. Rather, Fisher describes a motor that includes a housing formed by a motor shell and a pair of endshields. APA describes a motor housing that includes a shell having an inner surface and an outer surface, and a plurality of fasteners attached to the shell outer surface that extend radially outwardly from the shell outer surface. Story describes a replacement motor mounting that includes a set of fastener receiving holes that are configured to receive a plurality of fasteners that extend axially from an endshield. Boede describes a box that includes a cover having a plurality of recessed mounting holes that are configured to receive a plurality of mounting screws that are configured to attach to an outer surface of the box and extend inwardly through the box. For at least the reasons set forth above, Claim 1 is submitted to be patentable over Fisher in view of APA, Story and Boede.

Claims 2-4 depend from independent Claim 1. When the recitations of Claims 2-4 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-4 likewise are patentable over Fisher in view of APA, Story and Boede.

Claim 14 recites “a motor comprising: a pair of endshields; a housing extending between said endshields including at least one raised projection extending outwardly from said housing, said housing comprising an inner surface, said projection defining a recess with respect to said inner surface, at least one opening extending through said recess, and at least one fastener having a top surface, said at least one fastener extends outwardly through said housing such that said top surface is substantially co-planar with said inner surface; and a stator-rotor assembly mounted in said housing.”

None of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a motor including a pair of endshields, a housing extending between the endshields including at least one raised projection extending outwardly from the housing, the housing including an inner surface, the projection defining a recess with respect to the inner surface, at least one opening extending through the recess, and at least one fastener having a top surface, the at least one fastener extends outwardly through the housing such that the top surface is substantially co-planar with the inner surface, and a stator-rotor assembly mounted in the housing. More specifically, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a housing that includes at least one raised projection extending outwardly from the housing, the housing including an inner surface, the projection defining a recess with respect to the inner surface, at least one opening extending through the recess, and at least one fastener having a top surface, the at least one fastener extends outwardly through the housing such that the top surface is substantially co-planar with the inner surface. Rather, Fisher describes a motor that includes a housing formed by a motor shell and a pair of endshields. APA describes a motor housing that includes a shell having an inner surface and an outer surface, and a plurality of fasteners attached to the shell outer surface that extend radially outwardly from the shell outer surface. Story describes a replacement motor mounting that includes a set of fastener receiving holes that are configured to receive a plurality of fasteners that extend axially from an endshield. Boede describes a box that includes a cover having a plurality of recessed mounting holes that are configured to receive a plurality of mounting screws that are configured to attach to an outer surface of the box and extend inwardly through the box. For at least the reasons set forth above, Claim 14 is submitted to be patentable over Fisher in view of APA, Story and Boede.

Claims 15-20 depend, directly or indirectly, from independent Claim 14. When the recitations of Claims 15-20 are considered in combination with the recitations of Claim 14, Applicants submit that dependent Claims 15-20 likewise are patentable over Fisher in view of APA, Story and Boede.

Furthermore, Applicants respectfully submit that the Section 103 rejection of Claims 1-4 and 14-20 is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. None of Fisher, APA, Story, or Boede, considered alone or in combination, describe nor suggest the claimed

combination. Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Fisher with APA, Story and Boede, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Rather, only the conclusory statement that "[i]t would have been obvious to one skilled in the art at the time the invention was made to modify the housing by providing a plurality of fasteners circumferentially spaced about the housing and extending outwardly therefrom because one would have been motivated to enable the motor to be attached within an application as taught by the APA Figure 1 (lines 3-6 of page 1 of the instant specification)" suggests combining the disclosures.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicant's disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103(a) of Claims 1-4 and 14-20 be withdrawn.

The rejection of Claims 5-13 under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art ("APA") of Figure 1 in view of Story and in further view of Boede is respectfully traversed.

APA, Story, and Boede are described above.

Claim 5 recites "a housing for a motor extending between a pair of endshields, said housing comprising; an inner surface; an outer surface; at least one raised projection extending outwardly from at least one of said housing inner surface and said housing outer surface defining a recess with respect to said housing inner surface, said projection comprising at least one opening extending therethrough; and at least one fastener having a top surface, said at least one fastener extends outwardly through said housing opening such that said top surface is substantially co-planar with said housing inner surface."

None of APA, Story, or Boede, considered alone or in combination, describe or suggest a housing for a motor extending between a pair of endshields, the housing including an inner surface, an outer surface, at least one raised projection extending outwardly from at least one of the housing inner surface and the housing outer surface defining a recess with respect to the housing inner surface, the projection including at least one opening extending therethrough, and at least one fastener having a top surface, the at least one fastener extends outwardly through the housing opening such that the top surface is substantially co-planar with the housing inner surface.

More specifically, none of APA, Story, or Boede, alone or in combination, describe or suggest at least one raised projection extending outwardly from at least one of the housing inner surface and the housing outer surface defining a recess with respect to the housing inner surface, the projection including at least one opening extending therethrough, and at least one fastener having a top surface, the at least one fastener extends outwardly through the housing opening such that the top surface is substantially co-planar with the housing inner surface. Rather, APA describes a motor housing that includes a shell having an inner surface and an outer surface, and a plurality of fasteners attached to the shell outer surface that extend radially outwardly from the shell outer surface. Story describes a

replacement motor mounting that includes a set of fastener receiving holes that are configured to receive a plurality of fasteners that extend axially from an endshield. Boede describes a box that includes a cover having a plurality of recessed mounting holes that are configured to receive a plurality of mounting screws that are configured to attach to the outer surface of the box and extend inwardly through the box. For at least the reasons set forth above, Claim 5 is submitted to be patentable over APA in view of Story and Boede.

Claims 6-13 depend from independent Claim 5. When the recitations of Claims 6-13 are considered in combination with the recitations of Claim 5, Applicants submit that dependent Claims 6-13 likewise are patentable over APA in view of Story and Boede.

Furthermore, Applicants respectfully submit that the Section 103 rejection of Claims 5-13 is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. None of APA, Story, or Boede, considered alone or in combination, describe nor suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine APA with Story and Boede, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Rather, only the conclusory statement that "[i]t would have been obvious to one skilled in the art at the time the invention was made to have modified the housing by providing a plurality of fasteners circumferentially spaced about the housing and extending outwardly therefrom because one would have been motivated to enable the motor to be attached within an application as taught by the APA Figure 1 (lines 3-6 of page 1 of the instant specification)" suggests combining the disclosures.

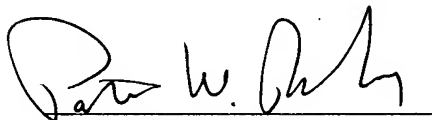
Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of

what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103(a) of Claims 5-13 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Patrick W. Rasche", written over a horizontal line.

Patrick W. Rasche
Registration No. 37,916
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070